

## REMARKS

In reply to the final Office Action of August 19, 2009 ("Office Action"), Applicant submits the following remarks. Claims 1, 4, 7-77, 90, and 91 are pending in this application, with claims 1, 24, 45, 56, and 77 being independent.

In the Office Action, claims 1, 24, 42-45, and 77 were rejected under 35 U.S.C. § 103 based on U.S. Patent No. 7,133,900 ("Szeto") and Trillian v0.73; claims 1, 4, 7-12, 14, 15, 17, 18, 20-32, 34, 35, 37-41, 45-48, 50, 51, 53-64, 66, 67, 69, 71-77, and 90-92 were rejected under 35 U.S.C. § 103 based on U.S. Patent No. 5,880,731 ("Liles") and Trillian v0.73; claims 13, 16, 33, 36, 49, 52, 68, and 70 were rejected under 35 U.S.C. § 103 based on Liles, U.S. Patent Application Publication No. 2002/0059425 ("Belfiore"), and U.S. Patent No. 5,963,217 ("Grayson"); claims 13, 16, 33, 36, 49, and 52 were rejected under 35 U.S.C. § 103 based on Szeto, Belfiore, and Grayson; claims 19 and 82 were rejected under 35 U.S.C. § 103 based on Liles, Belfiore, and U.S. Patent No. 5,745,556 ("Ronen"); and claim 65 was rejected under 35 U.S.C. § 103 based on Liles, Belfiore, and U.S. Patent No. 5,944,780 ("Chase"). Applicant submits that these rejections should be withdrawn for at least the following reasons.

### Section 103 rejection based on Szeto and Trillian v0.73

Applicants request reversal of the rejections of claims 1, 24, 42-45, and 77 because neither of Szeto, Trillian v0.73, or any proper combination of the two describes or suggests all of the features of independent claims 1, 24, 45, and 77, as described more fully below.

Amended independent claim 1 recites, among other things, the following feature:

a module for mapping the accessed personalization item selected in the non-chat, instant messaging context, which involves one-to-one communications, to a chat context, which involves one-to-many communications, the mapping being based on definitions of personalization items in the chat context and definitions of the personalization items in the non-chat, instant messaging context, wherein at least one of the definitions of personalization items in the chat context differing from at least one of the corresponding definitions of the personalization items in the non-chat, instant messaging context.

Szeto and Trillian v0.73, whether taken alone or in proper combination, fail to disclose or suggest mapping the accessed personalization item selected in the non-chat, instant messaging context to a chat context as recited in claim 1.

Szeto discloses a method for sharing an instant messaging environment where an environment selected by a participant is passed to the other participants in the instant messaging system through the use of environment identifiers. See Szeto, Abstract and col. 7, lines 17-37. As the Office Action acknowledges, Szeto does not disclose or suggest at least the “module for mapping” noted above. *See Office Action, p. 3.*

Recognizing deficiencies in Szeto, the Office Action turns to Trillian v0.73. On page 3, the Office Action asserts that “[t]he general concept of migrating items from one context to another via mapping is well known in the art as taught by Trillian.” However, the screenshot of Trillian v0.73 provided with the Office Action only shows that one “Buddy Icon” may be used “for all connections.” However, it is unclear what constitutes “all connections.” At best, the Trillian v0.73 screenshot teaches that a “buddy icon” can be shared across multiple applications (e.g. AIM and ICQ) within the same non-chat, instant message class, not from one type of application to another type of application.

Conversely, the “module for mapping” feature of claim 1 maps personalization items from one type of application—a non-chat, one-to-one, instant messaging context—to another type of application—a one-to-many, chat context. Referring to the Trillian screenshot, the Office Action asserts “trillion [sic] does enable users to use both an IM and chat environment, as a user can have multiple IM windows open talking to many different users, thus meeting the claimed definition of chat as being ‘one to many.’” However, each of the multiple “IM windows” referred to by the Office Action is a form of one-to-one communication. Multiple instances of a one-to-one communication do not constitute one-to-many communication.

These two classes of application are different in other respects, as well. For example, non-chat, instant messaging facilitates interruption of a user for communications initiated by another participant, whereas chat requires the user to navigate to one of many virtual areas to communicate with a plurality of other participants. Since these two types of applications are different, Trillian v0.73 cannot disclose or anticipate the “module for mapping” in independent claim 1 and thus fails to cure the deficiencies of Szeto.

The Office Action also asserts that “that it is possible to map different icons for different ‘connections’ using the dropdown box under the ‘use one icon for all connections’ checkbox.” Initially, Applicant notes that, without further documentation, it is unclear exactly what the “dropdown box under the ‘use one icon for all connections’ checkbox” actually accomplishes. At best, the “dropdown box” enables the user to select a specific buddy icon to be associated with a specific instant messaging connection. However, there is no “mapping” of the buddy icon. Rather, the user simply indicates the specific buddy icon to be utilized for a specific instant messaging connection. Conversely, claim 1 recites mapping the accessed personalization item selected in the non-chat, instant messaging context (e.g., the specific buddy icon) to a chat context.

For at least the foregoing reasons, Szeto and Trillian v0.73—taken alone or in any proper combination—fail to disclose or suggest each and every element recited in independent claim 1. Therefore, Applicant requests reconsideration and withdrawal of the section 103 rejection of claim 1 and its dependent claims.

Amended independent claim 24 and 45 recite, among other things, a computer implemented method and computer readable storage device, respectively, including:

storing, in a memory accessible to a chat host system, a mapping of definitions of the personalization items in a chat context, which involves one-to-many communications, to definitions of the personalization items in the non-chat, instant messaging context, which involves one-to-one communications, wherein at least one of the definitions of personalization items in the chat context differing from at least one of the corresponding definitions of the personalization items in the non-chat, instant messaging context.

Applicant submits that this feature of claims 24 and 45 is not disclosed or suggested by Szeto and Trillian v0.73 for at least similar reasons, as discussed above. Therefore, the section 103 rejection of claims 24 and 45 and their dependent claims based on Szeto and Trillian v0.73 should be withdrawn for at least reasons similar to those presented above in connection with claim 1.

Similarly, amended independent claim 77 recites, among other things, a computer implemented method including:

mapping the stored personalization item from a non-chat, instant messaging context, which involves one-to-one communications, to

a chat context, which involves one-to-many communications, the stored personalization item having a meaning in the non-chat, instant messaging context that is different from a meaning in the chat context.

Applicant submits that this feature of claim 77 is not disclosed or suggested by Szeto and Trillian v0.73 for at least similar reasons, as discussed above. Therefore, the section 103 rejection of claim 77 and its dependent claims based on Szeto and Trillian v0.73 should be withdrawn for at least reasons similar to those presented above in connection with claim 1.

#### **Section 103 rejection based on Liles and Trillian v0.73**

Liles and Trillian v0.73 do not support a conclusion of obviousness with respect to claims 1, 4, 7-12, 14, 15, 17, 18, 20-32, 34, 35, 37-41, 45-48, 50, 51, 53-64, 66, 67, 69, 71-77, and 90-92. Liles discloses a system for representing participants in a chat session with avatars that may be animated. *See* Liles, Abstract. As the Office Action acknowledges, Liles does not disclose or suggest at least the “module for mapping” noted above. *See* Office Action, p. 8. Rather, the Office Action turns to Trillian v0.73 to cure this deficiency. As discussed above, however, Trillian v0.73 fails to describe or suggested the above-discussed features of independent claims 1, 24, 45, 56, and 77. Therefore, the section 103 rejection of claims 1, 24, 45, 56, and 77 and their dependent claims should be withdrawn.

#### **Section 103 rejection based on Liles, Belfiore, and Grayson**

The rejection of claims 13, 16, 33, 36, 49, 52, 68, and 70 based on Liles, Belfiore, and Grayson is improper, because claims 13, 16, 33, 36, 49, 52, 68, and 70 are dependent upon claims 1, 25, and 45, whose rejection is based on Liles and Trillian v0.73, not Belfiore. Applicants, therefore, respectfully request either (i) withdrawal of the section 103 rejection or (ii) a completed rejection curing the deficiencies of the asserted section 103 rejection.

#### **Section 103 rejection based on Szeto, Belfiore, and Grayson**

The rejection of claims 13, 16, 33, 36, 49, and 52 based on Szeto, Belfiore, and Grayson is improper, because claims 13, 16, 33, 36, 49, and 52 are dependent upon claims 1, 25, and 45, whose rejection is based on Liles and Trillian v0.73, not Belfiore. Applicants, therefore,

respectfully request either (i) withdrawal of the section 103 rejection or (ii) a completed rejection curing the deficiencies of the asserted section 103 rejection.

**Section 103 rejection based on Liles, Belfiore, and Ronen**

The rejection of claims 19 and 82 based on Liles, Belfiore, and Ronen is improper, because claim 82 was previously cancelled and claim 19 is dependent upon claim 1, whose rejection is based on Liles and Trillian v0.73, not Belfiore. Applicants, therefore, respectfully request either (i) withdrawal of the section 103 rejection or (ii) a completed rejection curing the deficiencies of the asserted section 103 rejection.

**Section 103 rejection based on Liles, Belfiore, and Chase**

The rejection of claim 65 based on Liles, Belfiore, and Chase is improper, because claim 65 is dependent upon claim 56, whose rejection is based on Liles and Trillian v0.73, not Belfiore. Applicants, therefore, respectfully request either (i) withdrawal of the section 103 rejection or (ii) a completed rejection curing the deficiencies of the asserted section 103 rejection.

**Conclusion**

It is requested that the Examiner reconsider the application in view of the remarks and timely allow the pending claims.

It is believed that all pending issues in the outstanding Office Action have been addressed by this paper. The Office Action, however, contains a number of statements reflecting characterizations of the related art and the claims. Whether or not any such statement is identified herein does not constitute an automatic subscription to any statement or characterization in the Office Action. In addition, there may be reasons for patentability of any or all pending or other claims that have not been expressed above.

If there are any questions regarding this paper or the application generally, a telephone call to the undersigned would be appreciated since this may expedite prosecution of the application.

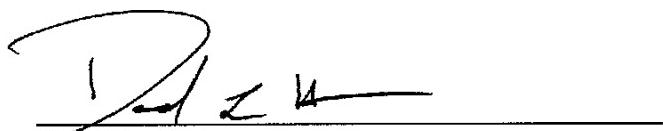
Applicant : Barry Appelman et al.  
Serial No. : 10/718,039  
Filed : November 21, 2003  
Page : 20 of 20

Attorney's Docket No.: 06975-0505001 / AOL 211

No fees are believed to be due. Please apply any required charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: NOVEMBER 19, 2007



David L. Holt  
Reg. No. 65,161

**Customer No. 26171**  
Fish & Richardson P.C.  
1425 K Street, N.W.  
11th Floor  
Washington, DC 20005-3500  
Telephone: (202) 783-5070  
Facsimile: (877) 769-7945

40608405.doc